

REMARKS

Reconsideration of the above-identified patent application is respectfully requested.

Claims 1-52 are pending in this application. The Examiner rejected claims 1, 7, 8-11, 19, 20, 26-28, 30, 31, 37-39, 40-42, and 50-52 under 35 U.S.C. §112 as being indefinite. The Examiner also rejected claims 1-11, 13-14, 16, 19-28, 30-42, 44, 45, 47, and 50-52 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Serial No. 6,678,877 to Perry et al. (hereinafter Perry). The Examiner rejected claims 15, 17, 18, 48, and 49 under 35 U.S.C. §103(a) as being unpatentable over Perry in view of U.S. Patent Serial No. RE36,602 to Sebastian et al. (hereinafter Sebastian). The Examiner rejected claims 12, 29, and 43 under 35 U.S.C. §103(a) as being unpatentable over Perry in view of U.S. Patent Application Publication Number 2004/0208354 to Vilella. The Examiner also provisionally rejected claims 1-52 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-052 of copending U.S. Patent Application Serial No. 10/780,990.

Double Patenting Rejections

Applicants respectfully request that all the provisional double patenting rejections be held in abeyance pending the issuance of the conflicting claims.

§112 Rejections

The Examiner rejected 1, 7, 8-11, 19, 20, 26-28, 30, 31, 37-39, 40-42, and 50-52 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Specifically, the Examiner contends that the above-identified claims are indefinite because each claim fails to communicate which machine performs the respectively recited “retrieving assembly cost . . . design data” and/or “retrieving assembly capability . . . design data” steps. Applicants respectfully traverse the Examiner’s

rejection. Each of the above-identified claims is definite. Applicants respectfully point out that either the server and/or the client machine may perform such process steps. The above-identified claim elements are not restricted to being performed by the same machine in all embodiments. As described in the last full paragraph on page 6 beginning at line 23 of the Applicant's specification, the cost database(s) 28 and/or the process capability database(s) 30 may be stored on the server 24 and/or on the client 12. As such, either the server or the client may perform the steps of "retrieving assembly cost . . . design data" and/or "retrieving assembly capability . . . design data" depending on the particular embodiment.

It appears that the Examiner is mistaking the breadth of the above-identified claims as indefiniteness. However, Applicants respectfully point out that the "breadth of a claim is not to be equated with indefiniteness" (See MPEP 2173.04). Additionally, MPEP § 2171 requires that claims be evaluated under 35 U.S.C. § 112, second paragraph, to determine "whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art." MPEP § 2173.02, titled "Clarity and Precision," requires that an Examiner "should allow claims which define the patentable subject matter with a *reasonable* degree of particularity and distinctness." Thus, the MPEP requires that a claim define patentable subject matter with a reasonable degree of particularity and distinctness so that the claims apprise one of ordinary skill in the art of their scope. Applicants' claims, including the elements of "retrieving assembly cost . . . design data" and/or "retrieving assembly capability . . . design data," define the patentable subject matter with more than a reasonable degree of particularity and distinctness.

Independent Claim 1

The Examiner rejected independent claim 1 as being anticipated by Perry. Claim 1 has been amended to recite "retrieving assembly cost data in response to and associated with the user-supplied electronic assembly design data from an assembly cost database, the assembly cost data including a materials cost and a processing cost." Perry fails to disclose or show such an

element. Rather, Perry discloses displaying only the materials cost of a design of a circuit: "FIGS. 22A and 22B show an exemplary BUILD IT web page. The build it page includes a bill of materials section that identifies the list of the parts used in the circuit." (Col. 14, ll. 44-46). Perry does not disclose the calculation and displaying of processing cost because Perry is not directed to the manufacturing of the circuit. Rather, Perry is directed only to the design process. As such, Perry fails to disclose retrieving assembly cost data wherein the cost data includes a materials cost and a processing cost.

Further, not only does Perry not disclose the calculation and displaying of a processing cost, it would not be obvious to modify Perry to include such a feature because Perry actually teaches away from the calculation and displaying of a processing cost. Perry clearly discloses that the circuit board must be self-assembled by the user or by a third party:

Returning to FIGS. 22A and 22B, when the user is has (sic) completed reviewing the bill of materials and other information, the user may click on the Order this Kit button 2230 to order the kit. According to one embodiment, the party that would handle the order of a single component would be the manufacturer or distributor of the component. However, the party that handles the "kit" order may be a third party. In response to the order of a kit, the party from whom the kit is ordered places corresponding component orders with the component manufacturers or obtains the parts from a local stock in a warehouse. The process of placing the corresponding component order can be executed automatically upon receipt and approval of a kit order.

If the user selects Order this Kit button 2230, the user will have the ability to receive the components and bare PC board to make the circuit. However, the user may prefer to receive the circuit itself, already assembled. Therefore, the user may alternatively or additionally be presented with an "order built-up board" button (not shown), which, when selected, causes the components, and optionally a PC board, to be ordered and sent to a circuit board assembler. The circuit board assembler assembles the circuit board from the ordered components and delivers the custom-assembled circuit board to the user that placed the order. (Col. 15, ll. 29-52).

As such, one would not be motivated to modify Perry to include the calculation and displaying of a processing cost because such costs are simply irrelevant (in embodiments wherein

the circuit is assembled by the user) or unknown (e.g., in those embodiments wherein the circuit is assembled by a third-party). Therefore, not only does Perry not disclose the calculation and displaying of a processing cost, it would not be obvious to combine Perry with any other reference disclosing such a feature because Perry clearly teaches away from such a combination. For all the reasons provided above, amended claim 1 is believed to be in condition for allowance. Because claims 2-19 depend from claim 1, these claims are also believed to be in condition for allowance.

Independent Claim 20

The Examiner rejected claim 20 as being anticipated by Perry. Claim 20 has been amended to recite “retrieving assembly capability data that indicates the manufacturing capability of an electronic assembly manufacturer in response to receiving the user-supplied electronic assembly design data from an assembly capability database.” Perry fails to disclose such a feature. In support of the current rejection, the Examiner points to column 6 of Perry, noting in this section or any other section of Perry discloses the retrieval of assembly capability data. However, this section of Perry is simply directed to the receipt of user requirements for the circuit such as maximum or minimum input voltages, output voltage, current, and the like. User requirements are not synonymous with assembly capability data as claimed in amended claim 20.

For at least the reasons provided above, amended claim 20 is believed to be in condition for allowance. Because claims 21-30 depend from claim 20, these claims are also believed to be in condition for allowance.

Independent Claim 31

The Examiner rejected claim 31 as being anticipated by Perry. Claim 31 has been amended to recite retrieving assembly capability data that indicates the manufacturing capability of an electronic assembly manufacturer in response to receiving the user-supplied electronic assembly design data from an assembly capability database.” For at least the reasons provided above in regard to claim 20, Perry fails to disclose such a feature. As such, claim 31 is believed to be in condition for allowance. Because claims 32-49 depend from claim 31, these claims are also believed to be in condition for allowance.

Independent Claim 50

The Examiner rejected claim 50 as being anticipated by Perry. Claim 50 has been amended to recite the retrieval of “assembly capability data that indicates the manufacturing capability of an electronic assembly manufacturer in response to receiving the user-supplied electronic assembly design data from an assembly capability database.” For at least the reasons provided above in regard to claim 20, Perry fails to disclose such a feature. As such, claim 50 is believed to be in condition for allowance. Because claims 51-52 depend from claim 31, these claims are also believed to be in condition for allowance.

Claim 1-52 have been amended. For at least the reasons provided above, amended independent claims 1, 20, 31, and 50 are believed to be in condition for allowance. Because claims 2-19 depend from claim 1, claims 21-30 depend from claim 20, claims 32-49 depend from claim 31, and claims 51 and 52 depend from claim 50, these claims are also believed to be in condition for allowance. Therefore, claims 1-52 are in condition for allowance, and such action is solicited.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and shortages in other fees be charged, or any overpayment in fees be credited, to the Account of

Barnes & Thornburg LLP, Deposit Account No. 10-0435 with reference to file 6890-74182.

Respectfully submitted,

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